

REMARKS

In the Office Action mailed on August 5, 2008 the Office Action noted that claims 1-16 were pending, and rejected claims 1-16. Claims 1, 9, 12 and 16 are amended, claims 4-5 and 10-11 are canceled, no new claims are added and, thus, in view of the foregoing claims 1-3, 6-9, 12-16 remain pending for reconsideration which is requested. No new matter is believed to be added. The Examiner's rejections are respectfully traversed below.

Rejections under 35 U.S.C. § 101

In the Office Action on page 19, item 4, claims 1, 9-11 and 16 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. While the applicable standard is no longer whether the claims produce "useful, concrete, and tangible results," the claims are amended and do transform a tangible object. (See *In re Bilski*, slip op. pages 19-20 and 10, (Fed. Cir. 2008)). For instance claim 2 recites "instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction and the confirmation, based on the real personal information." In other words, a tangible good is delivered to a real address based on the commercial transaction. Thus withdrawal of the rejection is requested.

Rejections under 35 U.S.C. § 112, second paragraph

In the Office Action on page 20, item 6, claims 1-8 and 16 are rejected under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The claims are amended and withdrawal of the rejection is requested.

In the Office Action on page 20, item 7, claims 12-15 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is amended and withdrawal of the rejection is requested.

Rejections under 35 U.S.C. § 103(a)

In the Office Action, on page 21, item 10, claims 1-5 and 8-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiloh provisional Application 60/191625 and Ferreira (2001/0034661). This rejection is respectfully traversed below.

As discussed in the Personal Interview on November 25, 2008, the Ferreira publication (2001/0034661) is disqualified as a reference because the Applicants have perfected a claim for

priority by filing the certified English translation of the priority document which is dated January 17, 2001. Because the Office Action bases its rejection of the claims on paragraphs found in the above reference, this rejection is respectfully traversed. Only Ferreira's provisional application may be used as a prior art reference against this Application. Thus, the Examiner may only rely on what is disclosed in the provisional application.

The provisional Shiloh application discusses providing virtual users with buying power in the form of a virtual spending account with Virtuality to purchase products and services. Virtuality will provide users with a fictional user name and fictional user information to keep internet activity private. Virtuality notes that most products and services on the Internet do not require real world addresses including print your own products like bar coded stamps, movie tickets, music, videos, and hotel reservations. However, Virtuality does note that products only available via shipping will be send to physical P.O. boxes established by Virtuality for a monthly fee. (See Shiloh, page 2, lines 1-5; page 3, lines 5-8; page 5, lines 1-8 and Proposed Model for Virtuality).

The provisional Ferreira application discusses a method and system for presenting a virtual representation of an actual city such as New York. In this virtual city, the user is provided a one-stop-shopping destination having merchandise from large e-commerce sites as well as local vendors. Ferreira's virtual cities are designed such the user need only enter their sensitive credit card information one time. However, this actual credit card information is sent over a network and used to make purchases. Thus, actual information is sent during each purchase. Ferreira's one-stop-shop merely provides that shoppers enter their personal information once. When a purchase is made, an e-mail with credit card information and the actual name is sent to a warehouse shipper as well as to VirtuaCities and VirtuaCities processes payment. Furthermore, Ferreira discusses that it will sell purchaser information to retail companies to help them market their goods and purchasers will receive sales solicitations based on their past purchases. (See Ferreira, page 2, paragraph 2; page 6, Web-Surfers Bullet List; page 8, paragraph 3; page 12, paragraphs 2-4; pages 18-19, Marketing Services). The Office Action, on page 23, admits that Shiloh does not teach registered information. However, the Office Action asserts that paragraph [0085] of the Ferreira publication teaches registered information.

This paragraph merely indicates that Ferreira provides a one-stop-shopping destination. However, as discussed above, this reference is disqualified. Although Ferreira's provisional also discusses one-stop-shopping on page 8, as described above, "registration" in Ferreira is related to providing actual information including sensitive credit card information to VirtualCities, not

“converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network” as recited in claim 2. Thus, Ferreira is not concerned with protecting a user’s information because actual credit card information is sent over a network during every purchase and furthermore, Ferreira’s ultimate goal discusses selling its customers’ actual personal information. Thus, one of ordinary skill in the art at the time of the invention would not have been motivated to combine Shiloh’s provisional application with Ferreira’s provisional application to teach “converting the virtual personal information into the real personal information based on registered information, in a managing apparatus provided in the network.” Thus, claim 2 patentably distinguishes over Shiloh’s provisional application and Ferreira’s provisional application, either alone or in combination.

Further, nothing cited by the Office Action or found in either reference teaches or suggests “seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction, based on the virtual personal information.” In other words, a real person is contacted while keeping their real information from the seller. The real person is asked to confirm their purchase and if the confirmation occurs, then the method continues by “instructing delivery and/or settlement of an item from the managing apparatus depending on the commercial transaction and the confirmation, based on the real personal information.” In particular, nothing in either reference teaches seeking confirmation from an individual to deliver an actual item through the mail while keeping the user’s actual information protected. Thus, claim 2 patentably distinguishes over Shiloh’s provisional application and Ferreira’s provisional application, either alone or in combination.

Claim 9, as amended, recites “converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information” and “means for seeking confirmation on an approval of the commercial transaction from an individual in the real world who made the commercial transaction in the virtual world in which the virtual personal information is used, based on the virtual personal information.” Claim 9 patentably distinguishes over Shiloh’s provisional application and Ferreira’s provisional application, either alone or in combination.

Claim 12, as amended, recites “a manager mapping virtual personal information of a virtual world to real personal information” and “an approval of the transaction is sent by an individual in the real world who made the commercial transaction, based on the virtual personal

information." Claim 12 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

Claim 16, as amended, recites "managing registered information of the virtual user and real user to convert virtual information into real information of a person," seeking confirmation of the transaction from the real user; and delivering an item involved in the commercial transaction to the real user if the real user confirms the transaction." Claim 16 patentably distinguishes over Shiloh's provisional application and Ferreira's provisional application, either alone or in combination.

Accordingly, withdrawal of the rejection is respectfully requested.

The dependent claims depend from the above-discussed independent claims and are patentable over the cited references for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the cited references. For example, claim 14 and claim 15 recite "a virtual station through which the first virtual individual can move to another virtual city space." Thus, a real user may make a commercial transaction in one virtual city space using virtual information and move to another city space and make another commercial transaction in the other city space. (See "virtual station" as depicted in Figure 9 of the Application.) In particular, the cited references do not teach city spaces that are interconnected via stations. Ferreira merely discusses development of isolated virtual cities. It is submitted that the dependent claims are independently patentable over the cited references.

Summary

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 10/046,498

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

12/18

By: _____



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